REMARKS

The above amendment and these remarks are responsive to the Office action of 15 July 2003 by Examiner Hai V. Nguyen.

Claims 1-20 are in the case, claims 18-20 being newly added. No claims have yet been allowed.

35 U.S.C. 103

Claims 1-17 have been rejected under 35 U.S.C. 102(3) [sic, 103(a)] over Albers et al. (U.S. Patent 6,223,188 B1) in view of Ball et al. (U.S. Patent 6,366,933 B1).

Applicants traverse, and argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references

2. that were available to the inventor and

3. that teach

4. a suggestion to combine or modify the references,

5.   the combination or modification of which would

      appear to be sufficient to have made the claimed

      invention obvious to one of ordinary skill in the

      art.

The fourth element of the prima facie case, the
suggestion to combine, must come from the prior art. It is
insufficient to establish obviousness that the separate
elements of the invention existed in the prior art, absent
some teaching or suggestion, in the prior art, to combine
the elements. That a claimed invention may employ known
principles does not itself establish that the invention
would have been obvious, particularly where, as is the case
here, those principles are employed to deal with different
problems. The Examiner must consider the claim as a whole,
and not piece together the claimed invention using the
claims as a guide. The Federal Circuit has stated: "[o]ne
cannot use hindsight reconstruction to pick and choose among
isolated disclosures in the prior art to deprecate the
claimed invention. [See In re Fritch, 23 USPQ 2d 1780, 1784
(Fed. Cir. 1992)].

In this case, the principles employed in Albers and
Ball are employed to deal with different problems. Thus, in

the case of Ball, the HEAD command is used to retrieve the Last-Modified field from a W3 document for use in deciding when a page has been changed. (See Ball, Col. 11, lines 62-64 and Col. 12, lines 35-46).

In applying Albers and Ball to applicants claims, the Examiner states:

"Albers does not explicitly disclose responsive to said browser determining from said data file header that said data file data type and size are in accordance with said request for data, receiving from said browser a GET request, said browser responsive to either said data file data type or said size not being in accordance with said request for data, not issuing said GET request to said server; and thereafter responsive to said GET request, serving to said browser data corresponding to said header...." (Office Action, page 3.)

Applicants agree. Albers does not teach this aspect of applicants' invention. However, the Examiner immediately continues:

"...Thus, the artisan would have been motivated to look into the related network arts for potential methods and systems for implementing the servicing the browser user's requests for resources or objects over the internet." (Office Action, page 3.)

In this statement, as is signaled by the use of the word "thus", the Examiner is relying on applicants' own teachings for the motivation. That is, because the prior art doesn't teach the above aspect taught by applicants, the Examiner states that one would be motivated to look. From where does that motivation come? Certainly not from Ball or even Albers. It can only come from applicants' own disclosure.

The Examiner continues:

"In the same field of endeavor, Ball, related Method and Apparatus For Tracking And Viewing Changes On The Web, discloses in an analogous art internet data access. *Ball discloses the HEAD information provided by httpd (the HTTP server) for the URL....In addition, there is a threshold associated with each page to determine the maximum frequency of direct HEAD requests. If the page was visited within the*

threshold, or the modification date obtained from the

proxy-caching server is current with respect to the

threshold, the page is not checked. The threshold can

vary depending on the URL, with peri pattern matching

used to determine what threshold to apply. (Ball, col.

12, line 2- col. 13, line 14). [Office Action, page 3,

emphasis in original].

The Examiner then refers to Albers, as follows:

"Albers also suggests that in the case of hypermedia

documents on the WWW, the system retrieves the

information regarding the data file's size, its file

type by performing httpd HEAD request; this request is

similar to the request usually made to retrieve the

hypermedia document to which the link points; however,

instead of retrieving the entire hypermedia document,

only basic information stored in the hypermedia

document's header is returned; this saves the user the

time and resources that actually downloading the

hypermedia file would entail thus reducing tnetwork

traffic (Albers, col. 5, lines 24-39)." [Office

Action, page 4, emphasis in original.]

Applicants argue that there is no suggestion in this teaching of Albers to use the HEAD request to determine file size and type AND THEN ONLY WHEN the file size and file type match the user request issuing the GET request.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the Examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Applicants argue that the Examiner has not shown the required objective teaching or otherwise established

knowledge which would lead an individual to combine the relevant teachings of Albers and Ball; and further, such combination does not meet all the elements of applicants claimed invention.

All independent claims 1, 2, and 11-18 are directed to the concept of using the HEAD request to determine from the file header the file size and type AND THEN ONLY WHEN the file size and file type match the user request issuing a GET request to download the data portion of the file.

Applicants request that the rejection of claims 1-18 be reconsidered and withdrawn.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-20.

If, in the opinion of the Examiner, a telephone conversation with applicant(s) attorney could possibly facilitate prosecution of the case, he may be reached at the number noted below.

Sincerely,

R. G. Hartmann, et al.

By

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